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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09-933,762	08/22/2001	Shinichi Tochihara	35.C15691	6174

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EXAMINER

SHAH, MANISH S

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 11/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/933,762

Applicant(s)

TOCHIHARA ET AL 

Examiner

Manish S. Shah

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (# 5538549) in view of Eguchi et al. (# 6342289).

Kato et al. discloses an ink jet recording method and system, which employs an ink jet recording apparatus, which ejects the ink composition on the image-receiving layer (column: 2, line: 44-66). They also disclose that the ink employ in recording using pigmented coloring material, a resin in an aqueous medium (column: 3, line: 5-60). They also disclose that the ink of plural colors of at least cyan, magenta and yellow are used as the pigmented ink (column: 3, line: 5-30). They also disclose that the particle diameter of the pigment substantially fall within the range from 0.05 to 0.3  $\mu\text{m}$ , and the proportion of pigment particles having a particle diameter of 0.05 to 0.3  $\mu\text{m}$  is at most 30% based on the total number of particles of the pigment (column: 2, line: 1-5), and the resin contained in the pigment ink is within a range of from 1-10% by weight (column: 4, line: 3-10).

Kato et al. differs from the claim of the present invention in that the ink receiving layer of the recording medium is a porous layer comprises alumina hydrate and a resin

binder on a base material and has a pore volume ranging from 0.1 to 1.0 ml/g and has a BET specific surface area of ink receiving layer falls within a range from 20 to 450 m<sup>2</sup>/g.

Eguchi et al. teaches that the ink receiving layer of the recording medium is a porous layer comprises alumina hydrate and a resin binder on a base material (column: 3, line: 10-25) and has a pore volume ranging from 0.1 to 1.0 ml/g (column: 8, line: 33-35) and has a BET specific surface area of ink receiving layer falls within a range from 20 to 450 m<sup>2</sup>/g (column: 8, line: 42-45).

It would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the porous ink receiving layer taught by the Eguchi et al. into the ink jet recording method and system of Kato et al. because it has a high ink absorbency rate, sufficient surface hardness and due to that it gives high gloss, good light-fastness and good water-fastness printed image (column: 3, line: 10-17).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argued that Eguchi et al. didn't teach the ink containing pigment and resin in an aqueous medium. Kato et al. teaches that ink containing pigment and resin in an aqueous medium and use any kind of recording paper. Eguchi et al. teaches that the recording medium has a porous ink-receiving layer. So it would have been obvious to one of ordinary skill in the art to use the recording material of Eguchi et al. in to the ink jet recording method of Kato et al.

• Application/Control Number: 09/933,762  
Art Unit: 2853

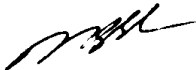
Page 4

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (703) 305-1562. The examiner can normally be reached on 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Barlow, Jr. can be reached on (703) 308-3126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-4900.



MSS  
October 21, 2002



ANH T.N. VO  
PRIMARY EXAMINER

10/31/02